

REMARKS/ARGUMENTS

Applicant has received and carefully reviewed the Final Office Action mailed on September 25, 2009. In the above-referenced Final Office Action, claims 1 and 3-63 are pending, with claims 3-5, 12-14, 21-22, 30-31, 38-39 and 44-63 previously withdrawn from consideration. Claims 1, 6-11, 15-20, 23-29, 32-37, and 40-43 have been rejected. After careful review, Applicant must respectfully traverse all assertions and rejections made in the Final Office Action. Favorable consideration of the following comments is respectfully requested.

Claim Rejections – 35 U.S.C. 102

In the Final Office Action, claims 10, 15-17, 28, 32-34, 36, and 40-42 were rejected under 35 U.S.C. 102(e) as being anticipated by Johansen et al. (U.S. Patent No. 7,303,533). After careful review, Applicant respectfully traverses the rejection.

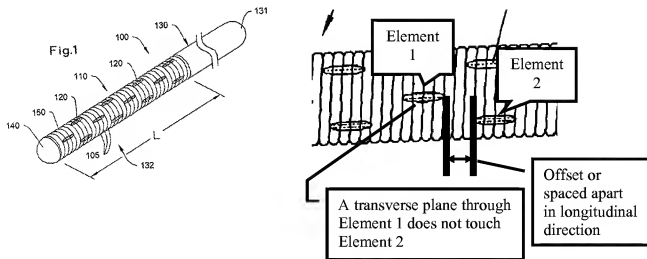
“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)...“The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (MPEP 2131).

Contrary to the assertions of the Examiner, Johansen et al. do not appear to disclose “wherein at least one of the plurality of joining elements is longitudinally offset from at least one other joining element along the coil length as viewed from a direction transverse to the coil axis”, as required by independent claim 10, “at least one of the plurality of joining elements is disposed more distal than at least one other joining element”, as required by independent claim 28, or “wherein at least one of the plurality of joining elements is disposed closer to the proximal end than at least one other joining element with no longitudinal overlap”, as required by independent claim 36.

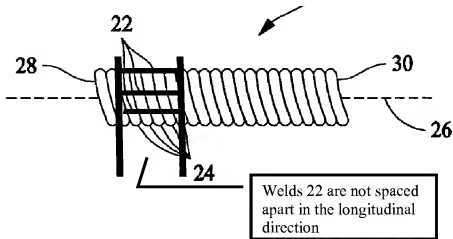
The Examiner maintains that Figure 2 shows three welds disposed along the length of the coil, that each of the three welds are longitudinally offset from one another, and that when

looking down the coil along axis 26, the joining elements are spaced without overlap. Applicant respectfully disagrees.

As can be readily seen in Figure 1 below, a plurality of joining elements are disposed along the length of the coil. That is, the joining elements are disposed at various locations from the proximal end to the distal end. Additionally, joining elements (by way of example only, illustrated as Element 1 and Element 2) of the current application are offset and spaced without overlap in such a way that if a transverse plane through the coil were created through one joining element, at least one other joining element would not intersect the plane. As an example, the spacing can be easily visualized by a coil winding disposed between the elements that is not joined to either element. Accordingly, at least one element is longitudinally offset, disposed more distal, or disposed closer to the proximal end with no longitudinal overlap compared to at least one other element.



Johansen et al., on the other hand, clearly do not appear to show such a configuration. Figure 2 of Johansen et al. is reproduced below for reference. As evidenced by the present specification, drawings, and claims, the claimed invention affects the entire coiled portion of the device. As can be easily seen, welds 22 of Johansen et al. appear to be disposed along only a portion of the coil length, appear to join the same coil windings, and do not appear offset or spaced apart in the longitudinal direction as shown above.



For at least the reasons discussed above, Johansen et al. do not appear to disclose or suggest each and every element of independent claims 10, 28, and 36; therefore, Johansen et al. cannot anticipate the claims. Similarly, claims 15-17, 32-34, and 40-42, which depend therefrom and add additional elements thereto, also cannot be anticipated by Johansen et al. Applicant respectfully requests that the rejection under 35 U.S.C. 102 be withdrawn.

Claim Rejections – 35 U.S.C. 103

In the Final Office Action, claims 1, 6-9, 11, 18, 29, 35, 37, and 43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. (U.S. Patent No. 7,303,533). After careful review, Applicant respectfully traverses the rejections.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03).

Similar to the discussion above, and with reference to the same figures, Johansen et al. do not appear to disclose “at least ten joining elements disposed along the coil length, wherein each joining element is located at a longitudinal position along the coil length relative to the coil axis and couples two or more coil windings, wherein the longitudinal position of at least one of the at least ten joining elements is longitudinally offset from the longitudinal position of at least one other joining element along the coil length”, as required by independent claim 1. Accordingly, Applicant believes that independent claim 1 is indeed patentable over Johansen et al.

Furthermore, for at least the reasons discussed above with respect to 35 U.S.C. 102, Applicant submits that Johansen et al. do not appear to expressly or inherently disclose or suggest each element of independent claims 10, 28, and 36, as is required to establish a *prima facie* case of obviousness. Accordingly, since claims 6-9, 11, 18, 29, 35, 37, and 43 depend from claims 1, 10, 28, or 36 and add additional elements thereto, Applicant submits that these claims are also nonobvious over Johansen et al. Applicant respectfully requests that the rejection under 35 U.S.C. 103 be withdrawn.

In the Final Office Action, claims 19, 20, and 23-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. (U.S. Patent No. 7,303,533) in view of Erickson et al. (U.S. Patent No. 5,664,580). After careful review, Applicant respectfully traverses the rejection.

As acknowledged by the Examiner, Johansen et al. do not disclose each joining element couples two or more coil windings...wherein the at least one joining element does not couple to any of the two or more coil windings coupled by the at least one other joining element, as required by independent claim 19. The Examiner asserts that Erickson et al. teach the missing limitation. Applicant respectfully disagrees, and further submits that the proposed combination is improper.

Erickson et al. appear to teach proximal and distal bonds 32/34 for joining coil 20 to wire 11. However, bonds 32/34 do not appear to be disposed on only a portion of the outer perimeter, as required by claim 19, since the bonds are expressly disclosed as bonding coil 20 to wire 11. Furthermore, modification of Johansen et al. to assume the configuration disclosed by Erickson et al. appears to impermissibly change the principle of operation of Johansen et al., thereby rendering the device unsuitable for its intended use (MPEP 2143.01 V-VI). Johansen et al. appears to expressly bond several (of the same) coil windings together using multiple welds 22 in parallel and/or intersecting patterns in order to shape the coil.

The Examiner also cites a portion of Erickson et al. that appears to disclose the bonding of proximal coil segment 22 to distal segment 24. The particular relevance of this is unclear, as Erickson et al. expressly disclose that the bonding of segments 22 and 24 is accomplished by welding adjacent turns of the coils together, and further that they are

"welded at four spots spaced about the circumference of the coil 20 but at approximately the same position along the length of the coil" (column 6, lines 52-56). Thus, Erickson et al. appears to expressly teach away from the claimed configuration.

Additionally, the rejection of claim 19 appears to suffer the same deficiencies noted above in the discussion related to the rejections under 35 U.S.C. 102. In particular, neither Johansen et al. nor Erickson et al. appear to disclose disposing joining elements along the coil length, or wherein at least one of the joining elements is longitudinally spaced apart from at least one other joining element.

For at least the reasons discussed above, the rejection of claim 19 appears to be improper. Therefore, Applicant believes independent claim 19 is indeed patentable over Johansen et al. and Erickson et al. Since claims 20 and 23-27 depend therefrom and add additional elements thereto, Applicant submits that these claims are also patentable over the cited combination. Withdrawal of the rejection under 35 U.S.C. 103 is respectfully requested.

Conclusion

Further examination, reconsideration, and withdrawal of the rejections are respectfully requested. It is submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his Attorney,

Date: 11-18-2009



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